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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/743,393      | 01/10/2001  | Takuya Seko          | Q62550              | 2333             |

7590

01/24/2002

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2100 Pennsylvania Avenue NW  
Washington, DC 20037

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| EXAMINER |
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HUANG, EVELYN MEI

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1625

DATE MAILED: 01/24/2002

*[Handwritten signature]*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/743,393

Applicant(s)

SEKO ET AL.

Examiner

Evelyn Huang

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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*Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 11, and claims 1-5, 8-10, 12-15 in part, drawn to a compound wherein R1 is thiazolidinyl, R3 is a carbocyclic ring, and R4 is a heterocyclic ring, the composition and method of use thereof. If this group is elected, an election of a species within this group is also required.

Group II, claim(s) 1-5, 8-10, 12-15 in part, drawn to a compound wherein R1 is thiazolidinyl, R3 is a carbocyclic ring, and R4 is a carbocyclic ring, the composition and method of use thereof. If this group is elected, an election of a species within this group is also required.

Group III, claim(s) 6, 7 and claims 1-5, 8-9, 12-15 in part, drawn to a compound not described in group I or group II, the composition and method of use thereof. If this group is elected, an election of a species within this group is also required and further restriction would be required based on the elected species.

The inventions listed as Groups I, II, III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Unity of invention exists where compounds included within a Markush group share a common utility *and* share a *substantial* structural feature disclosed as being essential to that utility. The only common core is -N-CH-C(O)-, which is *not* a *substantial* structural feature.

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The Markush elements in the instant claims are so diverse in scope that a common nucleus essential to that utility is lacking. For example, while these compounds are inhibitors of an N-type calcium channel, a compound within the genus of claim 1 is known to be antagonists of tachykinin (Esser, 5596000, PTO-1449).

A reference anticipates compounds being drawn to group I invention does not render obvious the compounds of group II or III invention. The search is not co-extensive and is burdensome. Since the search required for group I invention is not required for the other groups, the restriction requirement as indicated is therefore proper.

2. A telephone call was made to Mr. Boland on 1-15-2002 to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant has instead requested a written restriction.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention and a species within the elected invention to be examined even though the requirement be traversed (37 CFR 1.143).

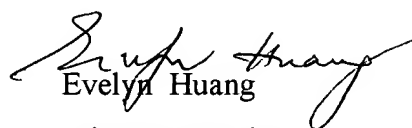
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 703-305-7247. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat can be reached on 703-308-2439. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

A handwritten signature in cursive script, appearing to read 'Evelyn Huang', is written over the printed name.

Evelyn Huang

Primary Examiner

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January 15, 2002